

REMARKS

Claims 1-42 are now pending.

The Examiner is thanked for his kind allowance of claims 1-16, 18-21, and 24.

Claim 22 has been amended to further particularly point out and distinctly claim subject matter regarded as the invention. Claims 1-21 and 23-25 have also been amended to make minor changes of a clerical nature.

New claims 26-42 have been added by this amendment and also particularly point out and distinctly claim subject matter regarded as the invention.

The drawing (FIG. 2) has been amended so as to conform to the description.

No "new matter" has been added by the amendment.

The 35 U.S.C. §102 Rejection

Claims 17, 22-23, and 25 stand rejected under 35 U.S.C. 102(b) as being allegedly anticipated by [Yamauchi et al. (U.S. Pat. No. 6,088,507)]. (Applicant understands that the Examiner meant to cite Yamaguchi, instead of Okada et al (U.S. Pat. No. 6,549,722), because the Examiner refers to Yamaguchi in his rejection and lists Okada as the prior art made of record and not relied upon in the Conclusion section.) This rejection is respectfully traversed.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference."

Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ 2d 1051,

1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 869 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). *See also*, M.P.E.P. §2131.

Claim 17 defines a method for rendering DVD subpicture data on a computer system having graphics data without a loss of subpicture resolution. The claimed method comprises (a) inserting a key into the subpicture data to indicate that the data is subpicture information and not the graphics data, and (b) writing the subpicture data to a primary surface, the primary surface also receiving the graphics data, as recited in claim 17.

The Examiner equates Yamaguchi's sub-stream ID (FIG. 7, column 10, lines 4-22 thereof) with the claimed key. However, this is not correct for the following reasons:

Yamaguchi discloses a multimedia optical disc, and a method and apparatus for reproducing data from the multimedia optical disc. The video data in Yamaguchi includes moving picture data and sub-data, and the sub-data includes audio data and sub-picture data (ABSTRACT of Yamaguchi). As illustrated in FIGS. 5-7 of Yamaguchi, the stream ID in a packet header data of each pack indicates whether the pack is a video pack (ID: 1110 0000) containing moving picture data, or a sub-data pack (or private packet 1) (ID: 1011 1101) containing the sub-data, either audio data or sub-picture data. Then, the sub-stream ID in the data field indicates whether the sub-data pack is an audio pack (with five higher bits specifying coding type) or a sub-picture pack (with three higher bits

“001”). It should be noted that the three higher bits “101” and “100” of the coding type identifier (shown in FIG. 6) function as an audio data identifier, since they are different from the three higher bits “001” of the sub-picture identifier (shown in FIG. 7).

Accordingly, Yamaguchi’s sub-picture identifier (the alleged key) indicates that the data is sub-picture but not the *audio* data. Accordingly, Yamaguchi fails to disclose inserting a key into the subpicture data to indicate that the data is subpicture information and not the *graphics* data, as recited in claim 17.

In addition, the system decoder **96** of Yamaguchi identifies the stream ID and sub-stream ID of the pack (each logical block of the video objects) from the buffer memory, and outputs the video data, audio data, and sub-picture data separately to the respective decoders **87**, **88**, and **89** (column 16, lines 42-47, FIG. 18 of Yamaguchi). Thus, there is no place or step where the sub-picture data is stored or written to with graphics data. Actually, there is no graphics data is used in Yamaguchi’s system. Accordingly, Yamaguchi also fails to disclose or suggest writing the subpicture data to a primary surface, the primary surface also receiving the graphics data, as recited in claim 17.

Claims 22, as amended, and claim 25 also include substantially the same distinctive features as claim 17. Claim 23 has been amended to depend from claim 22. Accordingly, it is respectfully requested that the rejection of claims based on Yamaguchi be withdrawn.

In view of the foregoing, it is respectfully asserted that the claims are now in condition for allowance.

Request for Allowance

It is believed that this Amendment places the above-identified patent application into condition for allowance. Early favorable consideration of this Amendment is earnestly solicited.

Allowable Subject Matter

The Examiner is thanked for the kind allowance of claims 1-16, 18-21, and 24. Applicants acknowledge the Examiner's statement of reasons for allowance as set forth in the Office Action. However, Applicants point out that the reasons for allowability of the above referenced claims are not limited to the reasons for allowance as set forth in the Office Action, and that additional reasons for allowability may exist, each of which may be independently sufficient to establish the patentability of one or more pending claims.

Applicants respectfully reserve the right to introduce, articulate, or otherwise comment on any such additional reasons for allowance as may be appropriate in any future proceedings concerning the claimed invention.

If, in the opinion of the Examiner, an interview would expedite the prosecution of this application, the Examiner is invited to call the undersigned attorney at the number indicated below.

Respectfully submitted,
THELEN REID & PRIEST, LLP

Dated: September 4, 2003



Masako Ando

Limited Recognition under 37 CFR §10.9(b)

Thelen Reid & Priest LLP
P.O. Box 640640
San Jose, CA 95164-0640
Tel. (408) 292-5800
Fax. (408) 287-8040



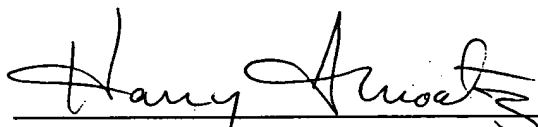
**BEFORE THE OFFICE OF ENROLLMENT AND DISCIPLINE
UNITED STATE PATENT AND TRADEMARK OFFICE**

LIMITED RECOGNITION UNDER 37 CFR § 10.9(b)

Masako Ando is hereby given limited recognition under 37 CFR § 10.9(b) as an employee of Thelen, Reid & Priest LLP to prepare and prosecute patent applications wherein the patent applicant is the client of Thelen, Reid & Priest LLP, and the attorney or agent of record in the applications is a registered practitioner who is a member of Thelen, Reid & Priest LLP. This limited recognition shall expire on the date appearing below, or when whichever of the following events first occurs prior to the date appearing below: (i) Masako Ando ceases to lawfully reside in the United States, (ii) Masako Ando's employment with Thelen, Reid & Priest LLP ceases or is terminated, or (iii) Masako Ando ceases to remain or reside in the United States on an H-1 visa.

This document constitutes proof of such recognition. The original of this document is on file in the Office of Enrollment and Discipline of the U.S. Patent and Trademark Office.

Expires: January 1, 2004



Harry I. Moatz
Director of Enrollment and Discipline

RECEIVED

SEP 12 2003

Technology Center 2000



Annotated Sheet Showing Changes
Thelen Reid & Priest, LLP
David B. Ritchie
Serial No.: 09/458,109
Filed: December 8, 1999

PAPER # 9

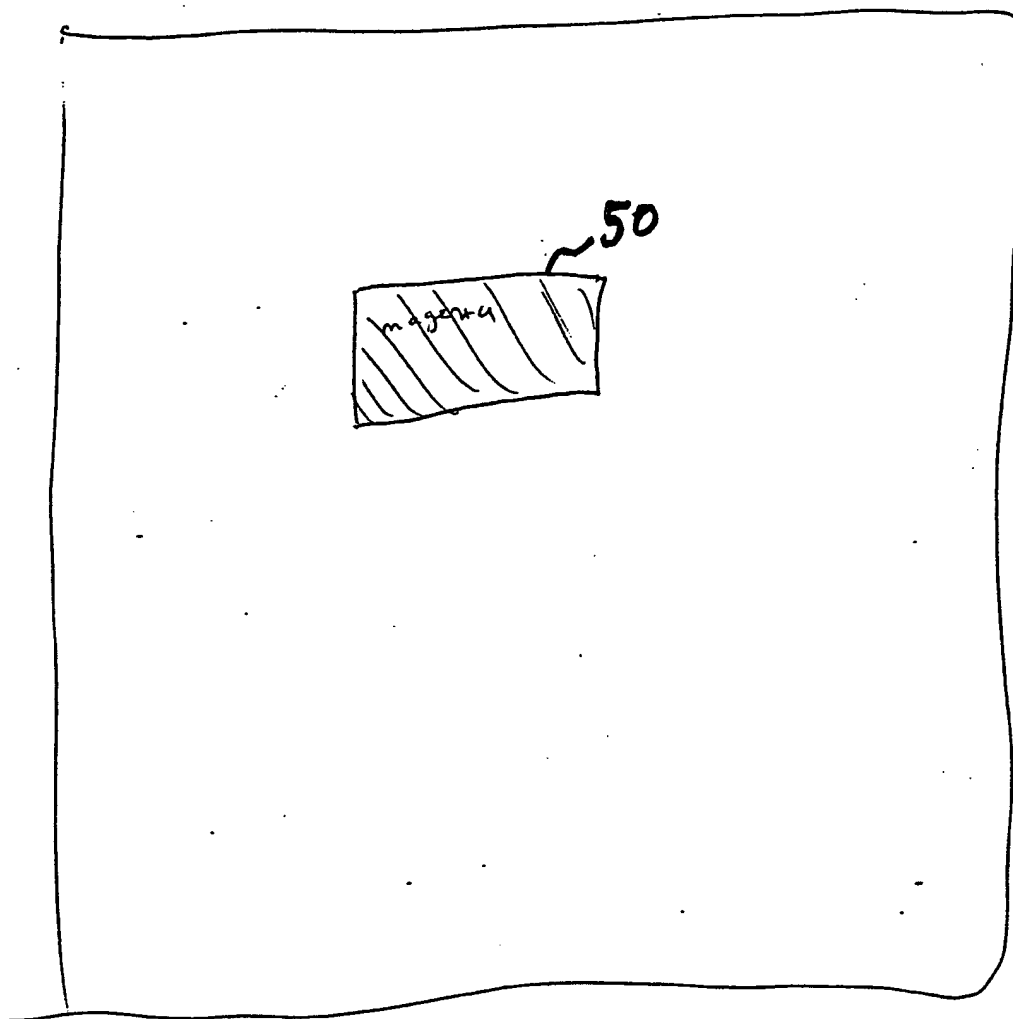


FIG. 2